

REMARKS

This paper is responsive to a Final Office Action mailed May 17, 2007. Prior to this response, claims 1-4, 7-13, and 16-19 were pending. After amending claims 1, 4, 7-10, 13, 16, and 18-19, and canceling claims 2 and 11, claims 1, 3-4, 7-10, 12-13, and 16-19 remain pending.

In Section 3 of the Office Action, claims 7-8 and 19 have been rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. Specifically, the Office Action states that "comparing the access code to the hashed password" is not enabled. In response, the claims have been amended to either compare an access code to a password, or a hashed access code to a hashed password.

In Section 5 of the Office Action, claims 1-4 and 7-8 have been rejected under 35 U.S.C. 112, second paragraph, for being indefinite. In particular, the Office Action states that the recitation of "encrypted document data" in claim 1 is unclear. In response, claim 1 has been amended to recite "encrypted document [[data]]".

In Section 8 of the Office Action claims 1-4, 7-13, and 16-19 have been rejected under 35 U.S.C. 103(a) as being unpatentable with respect to Hutchinson (US 2003/0145218) in view of McGraw (US 6,542,261). The Office Action acknowledges that Hutchinson does not expressly disclose a file including an unencrypted header that identifies the encrypted document. The Office Action states that McGraw discloses the transmission of an encrypted document, and an unencrypted header with an identification of the scanned document. The Office Action states that it would have been obvious to incorporate McGraw's unencrypted header into Hutchinson's method, with

the motivation being the "printed or viewed received FAX will have the unencrypted header at the top of the page so that the receiving party ... will know to whom the received secure FAX document should be given to". This rejection is traversed as follows.

An invention is unpatentable if the differences between it and the prior art would have been obvious at the time of the invention. As stated in MPEP § 2143, there are three requirements to establish a *prima facie* case of obviousness.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaack* 947 F.2d 488, 20 USPQ2d, 1438 (Fed. Cir. 1991).

Hutchinson generally describes a printer that is able to use PGP encryption to store electronic copies of a document. At paragraphs 0014 and 0029, the Office Action states that Hutchinson alludes to the transmission of an encrypted document with a password from a source to a network-connected printer, with the quote that "...it is conceivable that the present invention can be embodied in a combination of separate devices..." However, a careful reading of the paragraph shows that Hutchinson is using this quote to describe only printing and scanning functions. Paragraph 0014 is as follows:

[0014] FIG. 1 is a simplified elevational view of a digital copier and an associated computer, showing the essential elements thereof relevant to the present invention. *Although the*

Figure shows the scanning and printing functions (emphasis added) of a digital copier 10 within a single "box," it is conceivable that the present invention can be embodied in a combination of separate devices, such as a standalone scanner, general-purpose computer, and network-controlled printer. One or more such copiers 10 can in turn be interconnected to any number of computers, and/or to each other, using known network protocols and systems; the invention could also be directed to a context including a facsimile machine. Original sheets, bearing images to be copied, are placed on an input tray 12, where they are automatically fed by generally known means such as a document handler including a constant-velocity transport (CVT) roll 14, and then placed in catch-tray 16. While each sheet is moved on CVT roll 14 through what can be called a scanner process direction P1, successive small areas on the sheet are illuminated and recorded by a linear photosensor array 18, which may be of any type known in the art such as a charge-coupled device (CCD) or CMOS device, along with appropriate optics (not shown), which converts the light reflected by the small areas into digital data. The array 18 may also be used for exposure of images on sheets which are placed on a platen, in a manner familiar in the art.

The Applicant respectfully submits that the distribution of printing and scanning functions over multiple "boxes" cannot fairly be interpreted as evidence that Hutchinson suggests the transmission of encrypted documents with an accompanying password. Although Hutchinson describes network connected printers in [0013-0014], he is absolutely silent on the subject of sending an encrypted document through the network to a printer. In fact, Hutchinson clearly states that he is interested in encrypting data that is scanned (locally) and retained in memory (Abstract). Likewise, Hutchinson only creates a sessions key [0021] for local use. In [0025] Hutchinson describes sending the key from the scanner to the printer. But, the scanner and printer are co-located in the same machine (Fig. 1). Hutchinson is absolutely silent on the subject of sending the key to a network-connected printer.

Alternately stated, Hutchinson describes a process that is completely *internal* to a device. Hutchinson does not describe the sending of secured information or password to a printer from a network-connected device, or the printing of the document if the submitted password matches an access code received with the encrypted document.

McGraw describes a system that transmits an encrypted fax document with an unencrypted heading, indicating the intended recipient (col. 3, ln. 1-30). The fax message, in either paper or electronic form, is converted into a graphics (scan) document. Typically, the encrypted fax paper document is scanned, and secure fax driver software decrypts the document (col. 4, ln. 9-31). In one aspect, a computer employees a custom "fax card" to streamline the process (col. 4, ln. 37-49).

The fax document can be encrypted using a number of well-known technologies (col. 4, ln. 30). However, McGraw does not transmit a password with the encrypted document. The user must select a code at the transmit side, but the code is not sent with the document (col. 6, ln. 17-34). The recipient must present a "decode code", but this code is not something that the user recovers from the received document (col. 6, ln. 38-62).

The secure FAX document includes an unencrypted header at the top of the page that identifies the receiving party and the sending party (Fig. 4). McGraw's FAX does *not* include an unencrypted header that identifies an encrypted document, the header is merely printed on the same page as encrypted fax. This is more than a semantic difference, as the encrypted portion of McGraw's fax could not be identified if it was separated from the header.

With respect to claims 1, 9, 10, and 19, the Hutchinson and McGraw references have been combined based upon the assumption that

combination of references discloses all the elements of the claimed invention. The Applicant's independent claims recite that a file is transmitted (or received) with a header and an encrypted document. The header includes an unencrypted identification of the document, and a password.

- 1) Neither Hutchinson nor McGraw discloses the transmission of a password.
- 2) Neither reference discloses the transmission of a password with an encrypted document.
- 3) Neither reference discloses the transmission of an unencrypted identification of the encrypted document.
- 4) Neither reference discloses the transmission of a password in a file header.
- 5) Neither reference matches a transmitted password to an access code entered into a printer local interface. These 5 limitations are recited in Applicant's claims 1, 9, 10, and 19.
- 6) Further, neither reference discloses the use of the unencrypted identification in the header as a means of identifying the encrypted document, so that encrypted document can be stored in printer memory, as recited in claims 10 and 19. Claims 3-4, and 7-8, dependent from claim 1, and claims 12-13 and 16-18, dependent from claim 10, also enjoy the same distinctions from the cited prior art.

With respect to the first *prima facie* requirement, the Office Action states that it would have been obvious to incorporate McGraw's unencrypted header into Hutchinson's system, with the motivation being that "printed or viewed received FAX will have the unencrypted header at the top of the page so that the receiving party ... will know to whom the received secure FAX document should be given to". Assuming for the moment that

there is a suggestion that 2 prior art references can be combined, the fact that 2 references can be combined does not necessarily mean that the combination suggests a modification that makes the claimed invention obvious. The test is not whether there is a motivation to combine prior art references, but rather, does the combination of references suggest a modification that makes the claimed invention obvious. This analysis is especially relevant if the combination of prior art references does not explicitly disclose every limitation of the claimed invention, as noted above in addressing the third *prima facie* requirement.

The first *prima facie* test is not supported if there is merely a suggestion that references be combined. Rather, the combination must suggest *modifications* to the prior art that would make the claimed invention obvious ("First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to *modify* (emphasis added) the reference or to combine reference teachings." *In re Vaack* 947 F.2d 488, 20 USPQ2d, 1438 (Fed. Cir. 1991), see MPEP 2143.01 III). This is especially true in the case where the combination of references do not explicitly disclose all the claimed invention limitations.

In this particular case, it is irrelevant that McGraw's fax provides an unencrypted header that identifies the receiving part, because the claimed invention neither recites fax communications or a header that identifies the receiving party. In fact, the references point away from the claimed invention, since the claimed invention uses the header to supply a password. Alternately stated, the claimed invention purposely chooses not to inform or identify a recipient. It is an added layer of protection that only the user (sender) knows that the printer is storing an encrypted document. This

added protection makes it all the more likely that only the user (sender) can recover and print the document.

The fact that McGraw describes a system that sends an unencrypted header, which identifies a recipient, does not explain how one with skill in the art could have modified the Hutchinson reference in such a way as to describe the claimed invention. As explained above in response to the third *prima facie* requirement, even when combined, Hutchinson and McGraw fail to disclose all of the claimed invention limitations. The above-quoted statement from Office Action does not explain how even a person with skill in the art could modify Hutchinson's encrypted/decrypted printer memory system, in light of a fax system that leaves the recipient's name unencrypted for delivery purposes. Alternately stated, the modifications needed to make the claimed invention obvious are not suggested by a desire to aid hotel delivery. Rather, to meet the first *prima facie* requirement, there must be an explicit teaching in the McGraw reference that shows one with skill in the art how the Hutchinson reference can be modified to yield the claimed invention. Such a *prima facie* case has not been made, simply because all the Applicant's claim limitations cannot be found in the two references.

Alternately, if the Examiner is relying upon the knowledge of a person with skill in the art to supply motivation lacking the Hutchinson/McGraw references, then additional evidence must be provided. Notable, when the source or motivation is not from the prior art references, "the evidence" of motive will likely consist of an explanation or a well-known principle or problem-solving strategy to be applied". *DyStar*, 464 F.3d at 1366, 80 USPQ2d at 1649. The Examiner has not supplied any explanation

of how one with skill in the art could possibly modify either Hutchinson or McGraw to yield all the explicit limitations recited in the base claims.

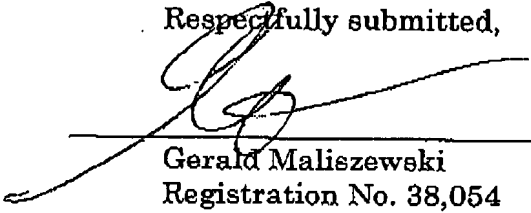
Considered from the perspective of the second *prima facie* requirement, even if one with skill in the art were given the Hutchinson and McGraw inventions as a foundation, no evidence has been provided to show that there is a reasonable expectation of success in the claimed invention.

In summary, the Applicant respectfully submits that a *prima facie* case of obviousness has not been supported, and the Applicant requests that the rejection of claims 1, 3-4, 7-10, 12-13, and 16-19 be removed.

It is believed that the application is in condition for allowance and reconsideration is earnestly solicited.

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Respectfully submitted,


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